

Office Action Summary

Application No.
09/185,243

Applicant(s)
Tsang et al

Examiner
Stroup, Carrie

Group Art Unit
1633



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-46 _____ is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-46 _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO. 09/233,243	FILING DATE 11/03/98	FIRST NAMED INVENTOR TSANG	ATTORNEY DOCKET NO. 15907-0016
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EXAMINER STROUP, C

ART UNIT 1633	PAPER NUMBER
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DATE MAILED: 03/25/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Art Unit: 1633

DETAILED ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 18-23, drawn to a method of treatment for pathogen, classified in class 424, subclass 184.1.
 - II. Claim 1-22, 24, 27-37, and 39-46 drawn to an expression construct, a method of expression of a transgene and method to treat cancer, in vivo, classified in class 435, subclass 320.1.
 - III. Claims 18-22, 25, and 38, drawn to a method of altering genetic material of a mammal, classified in class 536, subclass 23.1.
 - IV. Claims 18-22, and 26, drawn to a method to promote nerve regeneration, classified in class 435, subclass 368.

Applicant is advised that where a single claim encompasses more than one invention as defined above, upon election of an invention for examination, said claim will only be examined to the extent that it reads upon the elected invention.

2. The inventions are distinct, each from the other because of the following reasons:

The inventions of groups I-IV are drawn to materially different methods. The invention of group I is drawn to a method of treatment of pathogens; the invention of group II is drawn to a method of treatment of cancer; the invention of group III is drawn to a method of treatment for genetic deficiencies; and the invention of group IV is drawn to a method of regenerating nerve growth. Each of these methods require different expression constructs encoding different therapeutic proteins, and different methods of utilization of said constructs to treat a disorder.

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3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their divergent classifications, recognized divergent subject matter and further because the searches required for the different inventions are not coextensive, restriction for examination purposes as indicated is proper.

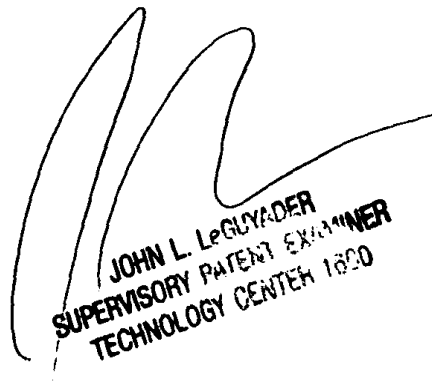
4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet Kerr whose telephone number is (703) 305-4055. The examiner can normally be reached on Monday through Friday from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John LeGuyader, can be reached at (703) 308-0294. The fax phone number for this Group is (703) 308-8724.

Janet Kerr



JOHN L. LeGUYADER
SUPERVISORY PATENT EXAMINER
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